

REMARKS

Claims 1-24 are pending in the present application.

Claims 1-24 were rejected.

No claims have been amended.

Claims 1-24 remain in the application.

The Applicants request reconsideration of Claims 1-24 in view of the following arguments.

In Section 1 of the February 17, 2004 Office Action, the Examiner rejected Claims 1-3, 5-8, 11-15, 17-20, 23 and 24 under 35 U.S.C. §102(e) as being anticipated by United States Patent Application Publication No. US 2001/0049263 to *Zhang* (hereafter, simply "*Zhang*"). In Section 2 of the February 17, 2004 Office Action, the Examiner rejected Claims 4, 9, 10, 16, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over *Zhang* in view of United States Patent No. 6,333,973 to *Smith et al.* (hereafter, simply "*Smith*").

The Applicant respectfully disagrees with the rejection of Claims 1-24 and directs the Examiner's attention to Claim 1, which contains the unique and non-obvious limitations emphasized below:

1. (Original) For use in a wireless network comprising a plurality of base stations, each of said base stations capable of communicating with a plurality of mobile stations, a mobile station diagnostic testing system capable of testing the operation of a first one of said plurality of mobile stations comprising:
 - a database capable of storing a mobile station diagnostic testing file comprising a mobile station diagnostic testing program in interpreted byte-code format; and
 - a diagnostics controller coupled to said database capable of receiving a notification indicating that a fault has occurred in said first mobile station and further

capable, in response to receipt of said notification, of retrieving said mobile station diagnostic testing file from said database and transmitting said mobile station diagnostic testing file to said first mobile station, wherein receipt of said mobile station diagnostic testing file causes said mobile station to execute said mobile station diagnostic testing program in said mobile station diagnostic testing file. (emphasis added)

The Applicant respectfully asserts that the above-emphasized limitations are not disclosed, suggested, or even hinted at in the *Zhang* reference or the *Smith* reference, or in the combination of the *Zhang* reference and the *Smith* reference.

In rejecting Claim 1, the Examiner cited paragraphs 13-17 of the *Zhang* reference. The Examiner asserted that the text in paragraphs 13-17 disclosed all of the limitations of Claim 1, including 1) a database capable of storing a diagnostics testing file containing a diagnostic testing program and 2) a diagnostics controller capable of transmitting the diagnostics testing file to a mobile station, wherein the mobile station executes the diagnostic testing program in response to receipt of the diagnostic testing file.

The Applicants respectfully disagree with the Examiner's assertions regarding the subject matter disclosed in the *Zhang* reference. The text of paragraphs 13-17 of the *Zhang* reference relied upon by the Examiner states (in pertinent part):

[0013] ...an automatic mobile station system/performance monitoring and error reporting system and method is provided for sampling and automatically recording error and performance data of a mobile station. During the use of the mobile station by a user, internal error messages and performance red data are stored in a non-volatile memory, which allows this material to be stored even if the mobile station is powered down. After either a predetermined amount of time has passed, a predetermined number of errors have occurred and been accumulated, or a particular fatal error has occurred, this material may be transmitted to the service provider for

use thereby or by the product manufacturer...

[0014] Upon receipt of the performance and error information, a computer may be provided at the service provider to analyze this material, or to retransmit this material to the mobile station producer. Any other features and/or software elements of the mobile station may be monitored as desired by the service provider and/or station manufacturer. Upon receipt of the performance and error data from any number of users, a system provider, or product manufacturer may track the success and/or failure of a particular software upgrade or a particular new product, which is being used by certain users. Therefore, error feedback and performance feedback will be provided so that any adjustments which are necessary may be made.

[0015] Also in accordance with the invention, upon analysis of these error and performance data, instructions may be transmitted to each of a certain class of mobile stations in order to adjust the parameters of the software contained therein in order to improve performance or overcome any errors which may be occurring. Therefore, even certain users who did not complain of particular errors will have their software parameters adjusted, since the adjustment takes place by way of a broadcast to all users....

[0016] ...it may become necessary to provide users and owners of a particular mobile station a software upgrade which includes more information than may be readily transmitted as a broadcast. In this case, in accordance with the invention, an upgrade unit is provided to each user in order to upgrade the software within the mobile station. Specifically, in accordance with the invention, a small unit, which is preferably the size of a credit card or smaller, is provided which includes a non-volatile memory including all instructions and data for the required software upgrade. This card is simply attached to a data port of the mobile station by a user...

[0017] After completion of the software upgrade, the confirmation of the software upgrade may be transmitted as before, that is, as performance data of the unit. Thereafter, as noted above, the performance and error characteristics of the upgraded software may be monitored, in order to insure that they are operating properly, and in order to further allow for the manipulation of various parameters as necessary in order to streamline and guarantee optimum performance of the software and hardware. The software upgrade kit may be provided at extremely low cost, the power for running the kit being provided by the mobile system when the software upgrade kit is plugged into the data port thereof.

The Applicants respectfully assert that the above-cited portions of the *Zhang* reference do not disclose, suggest or even hint at the unique and non-obvious limitations recited in Claim 1.

The system disclosed in the *Zhang* reference monitors performance data transmitted by the mobile station. Analysis and diagnosis of the performance data occurs in the network, not in the mobile station. The *Zhang* reference does not disclose transmitting a diagnostic testing program to the mobile station for subsequent execution by the mobile station. Paragraphs 13-17 of the *Zhang* reference only mention transmitting instructions (i.e., commands) to the mobile station in order to modify software parameters already in the mobile station. Any diagnostic testing program that may be on the mobile station in the *Zhang* reference must already be in the mobile station in order for the system in the *Zhang* reference to operate.

Thus, the unique and non-obvious limitations emphasized in Claim 1 above are nowhere disclosed in the *Zhang* reference. Furthermore, the *Smith* reference does nothing to overcome the shortcomings of the *Zhang* reference. The *Smith* reference was introduced to disclose short messaging service (SMS) messages, a graphical user interface (GUI) program, and other dependent claim limitations. But the *Smith* reference is silent with respect to the unique and non-obvious limitations emphasized in Claim 1 above.

In sum, independent Claim 1 contains patentable subject matter over the *Zhang* reference, the *Smith* reference, and the combination of the *Zhang* and *Smith* references. Also, dependent Claims 2-5 depend from Claim 1 and contain all of the unique and non-obvious limitations recited in Claim 1. Thus, Claims 2-5 also are patentable over the cited prior art references.

Independent Claims 6, 13 and 18 contain limitations that are analogous to the unique and non-obvious limitations recited in independent Claim 1. This being the case, Claims 6, 13 and 18 are patentable over the *Zhang* reference, the *Smith* reference, and the combination of the *Zhang* and *Smith* references. Furthermore, dependent Claims 7-12, which depend from Claim 6, dependent Claims 14-17, which depend from Claim 13, and dependent Claims 19-24, which depend from Claim 18, contain all of the unique and non-obvious limitations recited in Claims 6, 13 and 18, respectively. Thus, dependent Claims 7-12, 14-17 and 19-24 also are patentable over the cited prior art references.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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